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OFFICE OF PETITIONS

In re Application of :
Anderson, et al. :
Application No. 07/978,891 : DECISION ON PETITION
Filed: November 13, 1992 :
Attorney Docket No. 27693-01001 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b) to revive the above-identified application as well as the petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.137(b)(4).

DECISION UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is hereby **GRANTED**.

This application became abandoned September 16, 1993 for failure to timely submit a proper reply to the non-final Office action mailed June 15, 1993. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed December 16, 1993. A letter of express abandonment was filed December 20, 2003.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See, In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

A review of the facts and circumstances surrounding the history of the instant application establishes that there is a no question that the entire delay in seeking to resume prosecution of the instant application for the sole purpose of closing a gap in prosecution was unintentional.

As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See, Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

A letter of express abandonment was filed December 20, 2003. The letter of express abandonment was filed after the application had become abandoned on September 16, 1993 for failure to timely respond to the non-final Office action mailed June 15, 1993. It is evident from the application history as well as the instant petition that applicants filed the letter of express abandonment with the understanding that the instant application had copendency with continuation-in-part application No. 08/149,099, now U.S. Pat. No. 5,736,137, filed November 3, 1993.

Applicants' intent not to abandon the instant application prior to the filing of a continuation application is bolstered by the fact that the instant application contained a general authorization to charge any additional fees due to Deposit Account No. 09-0017. See, 37 CFR 1.25(b) and 37 CFR 1.136(a)(3). Thus, at the time of submission of the continuation-in-part application on November 3, 1993, the Office had the requisite authority to charge deposit account No. 09-0017, in the instant application, the required extension of time fee. As this fee does not appear to have been previously charged, the required two month extension of time fee has been charged, as authorized.

Applicants' intent not to abandon the instant application prior to the filing of a continuation application is further bolstered by the fact that the continuation application in question, U.S. App. No. 08/149,099 filed November 3, 1993, was filed prior to the letter of express abandonment.

Accordingly, the abandonment is not deemed a "deliberate course of action" within the meaning of 37 CFR 1.137(b)(3).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See, MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See, H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See, Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See, Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

- (A) the date that the applicant first became aware of the abandonment of the application; and
- (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

Petitioners herein indicate that applicants first became aware that the application was abandoned prior to the submission of a continuation application on or about October 2007 when seeking to file a petition under 37 CFR 1.78 in related U.S. App. No. 10/911,703. The instant petition was promptly filed November 7, 2007 after petitioners undertook an investigation of the facts and circumstances concerning the abandonment of the instant application.

In view thereof, the instant petition has been carefully reviewed and found to have met all of the requirements of 37 CFR 1.137(b) in that: the reply required to the outstanding Office action or notice was previously filed (to wit, continuation-in-part application 08/149,099, filed November 3, 1993); (2) the petition fee has been received; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) the requirement for submission of a terminal disclaimer has been waived pursuant to 37 CFR 1.183, as set forth herein.

Accordingly the instant application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of the previously filed continuation-in-part application (U.S. App. No. 08/149,099, now U.S. Pat. No. 5,736,137).

DECISION UNDER 37 CFR 1.183

The petition under 37 CFR 1.183 is hereby GRANTED.

In accordance with 37 CFR 1.137(b), a grantable petition pursuant must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Petitioners herein seek waiver of the terminal disclaimer requirement of 37 CFR 1.137(b)(4). Petitioners argue that the abandonment of the application did not lead to a delay in prosecution. Petitioners further argue that the filing of continuing application No. 08/149,099 on November 3, 1993 represented a complete reply to the non-final Office action mailed in the instant application on June 15, 1993. Petitioners also argue that examination of continuing application No. 08/149,099 was not delayed due to the abandonment of the instant application.

Petitioners further assert the existence of extraordinary circumstances on the basis that applicants, who have obtained patents based on 35 USC 120 benefit claims to the instant application, have had no reason to expect that the claims for priority to this application under 35 USC 120 would not be held effective.

In accordance with 37 CFR 1.183, "[i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f)."

Further, in accordance with MPEP 711.03(c), "[i]n the event that an applicant considers the requirement for a terminal disclaimer to be inappropriate under the circumstances of the application at issue, the applicant should file a petition under 37 CFR 1.183 (and petition fee) to request a waiver of this requirement of 37 CFR 1.183. Such a petition may request waiver of this requirement in toto, or to the extent that such requirement exceeds the period considered by applicant as the appropriate period of disclaimer. The grant of such a petition, however, is strictly limited to situations wherein applicant has made a showing of an "extraordinary situation" in which "justice requires" the requested relief. An example of such a situation is when the abandonment of the application caused no actual delay in prosecution."

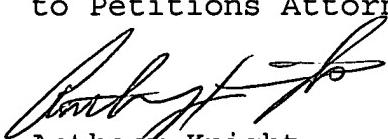
As argued by petitioners, the abandonment of the instant application caused no delay in actual prosecution of the instant application. This is so because applicants' reply to the non-final Office action, mailed June 15, 1993, was a continuation-in-part application filed November 3, 1993.

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Accordingly, it is found that given the facts and circumstances surrounding the history of the instant application, the requirement of 37 CFR 1.137(b)(4) may be waived.

This application is being forwarded to Files Repository.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.



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